

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. The examiner is requested to contact the undersigned at 858.314.1535 to discuss this response and/or suggestions on how to progress the prosecution of this case.

35 USC § 112

Claims 84-104 stand rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description and failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is respectfully submitted that the claims as previously submitted find support both explicitly and inherently in the application.

Claim 84 finds support, *inter alia*, in FIG. 1 and the corresponding passages in the specification. Interaction between the client system and the web server is identified as being bi-directional (as is typically the case with client /web server interactions). Note the bi-directional arrows and the parenthetical “results returned”. Such subject matter comprises support, for at least, the remote server (e.g., the web server) returning the output of the decision service (from the decision server) to the client system (e.g., reference 110 in FIG. 1).

Claim 104 finds support, *inter alia*, in that decision trees are displayed in a user interface and such decision trees can be manipulated (thus the relationship between the first decision tree and the second decision tree). P. 21, line 12, p. 22, lines 15-16, FIGs. 15-17 also provide support. For example, FIG. 16 shows a decision tree with relation to accounts receivable management (assign a strategy and assign various low / high, etc. settings).

Claim 84 was amended to recite: “receiving, at the client server, the input data from a user via the web page, the input data modifying the output” to clarify what is modifying the output.

Claim 105 was amended to delete the term “user” in the clauses cited by the examiner and to delete the phrase “wherein the web server”.

Claim 106 was amended to correct the antecedent basis for “results”.

Accordingly, the rejections under 35 USC § 112 should be withdrawn.

35 U.S.C. § 103

Claims 84 and 87 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts et al. (U.S. Patent No. 6,085,220) in view of Mears et al. (U.S. Patent 6,041,362) Claim 86 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts et al. (U.S. Patent No. 6,085,220) and further in view of Humplemann et al. (U.S. Patent No. 6,466,971). Claims 88 and 89 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts and Mears and further in view of Bertrand et al. (U.S. Patent No. 6,018,732). Claims 90-91 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts and Mears and further in view of Ballantyne et al. (U.S. Patent No. 6,687,873). Claims 92, 93, 96, and 103 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts and Mears and further in view of Berg et al. (U.S. Patent No. 5,999,911). Claim 94 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears and Berg and in further in view of Greenfeld (U.S. Patent No. 4,93,928). Claim 95 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, and Berg and in further in view of Schabes et al. (U.S. Patent No. 5,475,588). Claims 97-

99 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, and Berg and in further in view of Bertrand. Claim 100 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, Berg, and Bertrand and in further in view of Mical (U.S. Patent No. 4,772,882). Claims 101-102 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, and Berg and in further in view of Xie et al. (An additive reliability model for the analysis of modular software failure data). Claim 104 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts in view of Mears and Applicants Admitted Prior Art appearing on pages 1-7 of the originally filed specification ("AAPA"). Claim 105 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, and AAPA and in further in view of "An ASP You Can Grasp: The ABCs of Active Server Pages" by Cluts, and Meltzer et al. (U.S. Patent No. 6,226,675). Claim 106 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Courts, Mears, Cluts, Meltzer and Traversate et al. (U.S. Patent No. 7,577,834) and Ho et al. (U.S. Patent No. 5,836,771). These rejections are respectfully traversed.

The claimed subject matter is directed to an architecture which allows, *inter alia*, for decisioning software to be available as a service. This is contrast to conventional systems (including the systems described in the background of the application as well as described in the cited references), which either do not provide decisioning functionality or require enterprise / local installation to provide decisioning functionality. The claims were previously amended to further clarify this difference by including a client, web server, and decisioning server.

It is recognized that the USPTO must give claims their broadest reasonable construction consistent with the specification. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

However, the emphasis is on whether it is “reasonable.” *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Irrespective of the fact that the claims use the open ended term “comprising”, the Federal Circuit has instructed that any such construction be “consistent with the specification,” and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990) (quoting *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983)) (emphasis added). (*In re Suitco, Inc.*, Fed. Cir. 2009 -1418, April 14, 2010).

It is respectfully submitted that the interpretation of the business rules in a business layer is overly broad and that such features do not disclose the recited decision server or decision server. Such business logic cannot be used to help address new business problems, or experiment with existing decision processes, improve decisions over time through controller champion / challenger testing and the like (see, *inter alia*, specification p. 27, lines 11-20). In other words, the interpretation of a business layer as disclosing the recited decisioning service / server is not reasonable as required by case law.

In addition, the passage of Courts on col. 8, lines 18-41 merely states that a distributed computing environment can be implemented for a global session server (which is different than what is recited in the claims) as well as render engines (which also differ from the subject matter recited in the claims), and any interpretation that such broad and non-specific statements cover a client, web server, and decisioning server arrangement is not supported and is in violation of the recently decided *In re Suitco, Inc.* case. As a result of the deficiencies with Courts, the skilled artisan would not have resulted in the subject matter of any of the claims by combining any of the cited references.

Moreover, with regard to claim 104, Court also fails to suggest the subject matter of

claim 104 which is additionally directed to the display of decisioning models (in the form of trees) and how data is exchanged between the client and a remote decision server to allow a user to manipulate such trees in an interface rendered on the client. The combination of the business logic of Courts with a remote server and web server arrangement whether combined with APAA or otherwise does not suggest such a specifically claimed arrangement. The office is reminded that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 106 currently stands rejected in light of six references. The combination of the six cited references appear to have been assembled in a manner akin to the creation of Dr. Frankenstein's monster. The Office has apparently unearthed numerous unrelated elements from these references based an inventory list generated from the language of the instant claims and stitched these unrelated elements together to allegedly recited the claimed subject matter. This haphazard assemblage demonstrates a lack of proper concern or consideration for whether the assembled elements would function in a manner consistent with the claimed subject matter as is required for a proper rejection under 35 U.S.C. 103(a). Just as Dr. Frankenstein's monster was an abomination because of Dr. Frankenstein's failure to properly consider whether the various body parts he had assembled could properly form a functioning person, the Office's proffered rejection cannot stand because the elements assembled from the cited references merely skirt around the claimed subject matter without providing the requisite rationale that would have caused one or ordinary skill in the art to see a benefit or other motivation to create the claimed subject matter. See *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

As an example of the disparate nature of some of the cited references, Courts relates to

the management of an enterprise web system that provides web pages to users, Mears relates to integration of disparate information technology applications and platforms across an enterprise, Cluts relates to active server pages, Meltzer describes participant servers using self-defining documents which can be easily understood by all of the partners, Traversant relates to message authentication using message gates in a distributed computing environment, and lastly Ho relates to a learning method and system based on questioning in which a user polls a database to obtain an answer to a question in order to assess the level of understanding of a user with regard to a particular subject. While these references may skirt around the claimed subject matter, the skilled artisan would not have been motivated to combine such vastly differing technologies, and further, even if such technologies were combined, there are numerous deficiencies such as those described above in connection with the other claims. Additionally, the specifically claimed client system, decision server, web server, and code generator and their interrelation is such that the skilled artisan would not have resulted in the claimed subject matter.

Moreover, new claim 107 recites a specific arrangement which is not suggested by the state of the art, and as a result, the skilled artisan would not have resulted in this subject matter by combining the cited references.

Accordingly, all claims should be allowable.

Concluding Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending

claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-629001US.

Respectfully submitted,

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